

## REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-20.

The following claims are *independent*: 1, 16 and 20.

The following claims have previously been *cancelled* without prejudice or disclaimer: 21 and 22.

Please *amend* claims 1-6 and 9-20; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

### Claim Objections

The Office Action objected to claim 16 because of an informality. (See Office Action, p. 2). An appropriate correction has been made. Accordingly, the Applicant respectfully submits this objection has been overcome.

**Claim Rejections - 35 U.S.C. § 103**

The Office Action rejected claims 1-3, 5-9, 11 and 20 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Stewart, US Publication No. 2003/0135457 (hereinafter "Stewart"). Moreover, the Office Action rejected claims 4, 10, 14 and 16-19 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Stewart in view of Greene, US Publication No. 2002/0143686 A1 (hereinafter "Greene"). Lastly, the Office Action rejected claims 12, 13 and 15 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Stewart as applied to claim 1 above, and further in view of Dictionary of Economics by Wiley (1995) from www.xreferplus.com (hereinafter "Xreferplus").

Although Applicant continues to traverse the Examiner's rejection and submits the claims are patentably distinct for at least the reasons discussed in the Amendment and Response dated February 10, 2009, Applicant submits the amended claims are patentable over the cited references for at least the following reasons. For example, on page 4 of the Office Action, the Examiner asserts, "It would be obvious to one of ordinary skill in the art that reputational risk related to one's professional standing would be a factor in making the determination of opening an account." Applicant respectfully disagrees and submits Examiner's assertion is a merely conclusory statement, which is unsupported by any evidence. Such assertion with no citation to any evidentiary references is improper. Further, Applicant submits the amended claims are also patentably distinct from the cited reference.

Moreover, Greene was filed on March 9, 2001, less than six months earlier than Applicant's filing date of March 20, 2001. Therefore, it is not conceded that Greene was filed

in the US before the invention by the Applicants. Without so conceding, Applicants respectfully traverse the Examiner's rejection.

### **Requirements to Establish Prima Facie Obviousness**

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as "Graham factors," which include that "[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved." *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*<sup>1</sup>, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

<sup>1</sup> The "[Graham] factors continue to define the inquiry." 550 U.S. 398 (2007).

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A)** and **(B)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

### Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element as recited, *inter alia*, in currently amended independent claim 1:

A computer implemented method to manage risk related to opening a client account, the method comprising:

...

receiving client corporate structure data elements, with a corresponding risk level value for each data element, into a computer system relating to a client seeking to open the client account;

.... (Emphasis added).

Applicant submits the element cited above is not taught or suggested in Stewart, and the Office Action mischaracterized Stewart. Instead of the Office Action’s assertions,

Applicant submits that Stewart essentially discusses using a customer's personal information such as social security number, driver's license number and address. For example, Applicant notes that Stewart discusses, "[t]he authorization system 60 uses customer data such as the customer's social security number, driver's license number, and address to calculate the risk that an account will be closed for abuse at a later date...." (Stewart, para. [0020]). Further, Applicant notes that Stewart discusses, "[t]he [customer] data includes name, current and previous address, Social Security number, driver's license number information, date of birth, home and business telephone numbers, and e-mail address." (Stewart, para. [0048]). Applicant also notes that Stewart discusses, "Based on a credit score and key demographic variables..., the financial institution 10 determines which other products, if any, to offer to the customer 20." (Stewart, para. [0057]).

Therefore, Stewart does not teach or suggest at least the claimed, "...receiving client corporate structure data elements, with a corresponding risk level value for each data element, into a computer system relating to a client seeking to open the client account...", as recited in currently amended claim 1.

Similarly, Applicant submits that Greene's "online trading system" and Xreferplus' "weighted average" fail to remedy the deficiencies identified above in Stewart with regard to amended independent claim 1. For at least the reasons discussed above, Applicant submits that the pending rejection has mischaracterized the language of the claim elements and/or the applied references and, thus, has not established a *prima facie* case of obviousness.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

Although of different scope than independent claim 1, Applicant submits claims 16 and 20 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Stewart with regard to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

## **CONCLUSION**

Applicant asserts that the above remarks, which distinguish the claims over the cited references, pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office actions) (hereinafter "Office Actions"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary.

Further, any remarks that were made in response to the Office Actions' objection

and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Actions objections and/or rejections as to any other claim element(s), any such re-assertions of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertions of remarks.

Consequently, the references cited the Office Actions do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any Official Notice that has been taken and/or (mis)characterizations of claims made in the Office Action(s). As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited references and/or any Official Notice in the Office Actions.

Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-20, all: overcome all rejections and/or objections as noted in the Office Actions, are patentable over and discriminated from the cited references, and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and/or objections, and allowance of all claims.

### **Authorization**

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying

and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-449. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-449.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,  
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Dated: May 3, 2010

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